

REMARKS

Status of the Claims

Claims 1, 3-6, 12, and 14-31 are pending in the present application. Claims 3, 6, 12, 14-16, and 24-31 are withdrawn as being directed to a non-elected invention. Claims 2, 7-11, and 13 are canceled. Independent claims 1 and 22 are amended to clarify that the claimed DNA of (b) has a nucleotide sequence having 90% or more identity "over the full length sequence" with the DNA of (a). Accordingly, no new matter is entered by way of this amendment. Reconsideration is respectfully requested.

Issues Under 35 U.S.C. § 112, First Paragraph, Written Description

Claims 1, 4-5, and 21-23 are rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement, *see* Office Action, pages 2-3, items 1-3. Applicants respectfully traverse.

The Examiner states that the present application provides adequate written description for a DNA encoding a protein having enzymatic activity to hydroxylate the 16-position of the macrolide compound 11107B, wherein the DNA has "a nucleotide sequence having 90% or more identity *over the full length sequence* of nucleotides 1322 to 2548 of SEQ ID NO: 1", *emphasis in original*. However, the Examiner states that the instant claims encompass DNA molecules, which comprise a nucleotide sequence having 90% or more identity over less than the entire sequence of nucleotides 1322 to 2548 of SEQ ID NO: 1. Accordingly, the Examiner asserts that the instant claims are not adequately supported by the present application.

In an effort to expedite prosecution, independent claims 1 and 22 are amended to describe the subject matter, which the Examiner states is supported by the present application. Accordingly, the claims comply with the written description requirement. Withdrawal of the rejection is respectfully requested.

Claim Objections

Claims 17-20 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims, *see* Office Action, page 3, item 4. Applicants respectfully traverse.

As described herein, amended independent claim 1, upon which claims 17-20 depend, is allowable. Accordingly, reconsideration and withdrawal of this objection are respectfully requested.

Issues Under 35 U.S.C. § 102(b)

Claims 1, 4-5, and 21-23 stand rejected under 35 U.S.C. § 102(b) as allegedly anticipated by Nakajima, WO 2003/040370 ("Nakajima"), see Office Action, pages 3-5, items 5-10. This rejection is respectfully traversed.

The Examiner states that the instant claims do not require 90% identity over the full length sequence of nucleotides 1322 to 2548 of SEQ ID NO: 1. Accordingly, the Examiner alleges that Nakajima describes the claimed DNAs. In particular, the Examiner states that Nakajima discloses SEQ ID NO: 237, which encodes an herbicide metabolizing protein. The Examiner alleges that SEQ ID NO: 237 has an overall identity of 85.5% with nucleotides 1322 to 2548 of instant SEQ ID NO: 1. The Examiner further alleges that Nakajima discloses multiple nucleotide sequences of SEQ ID NO: 237 that comprise 100% identity to nucleotides 1322 to 2548 of instant SEQ ID NO:1. Accordingly, the Examiner asserts that Nakajima anticipates the instant claims.

As noted above, independent claims 1 and 22 are amended to clarify that the claimed DNA of (b) has a nucleotide sequence having 90% or more identity "over the full length sequence" of the DNA of (a). Accordingly, the sequences described in Nakajima do not anticipate the DNA described in independent claims 1 and 22. Dependent claims 4-5, 21, and 23, which incorporate the elements of independent claims 1 or 22, are also not anticipated by Nakajima. Accordingly, the rejection is overcome and withdrawal of the rejection is respectfully requested.

CONCLUSION

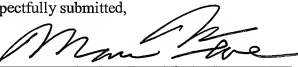
In view of the above amendment, Applicants believe the pending application is in condition for allowance.

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact Linda T. Parker, Ph.D., Registration No. 46,046, at the telephone number of the undersigned below to conduct an interview in an effort to expedite prosecution in connection with the present application.

If necessary, the Director is hereby authorized in this, concurrent, and future replies to charge any fees required during the pendency of the above-identified application or credit any overpayment to Deposit Account No. 02-2448.

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Respectfully submitted,

By 

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